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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
99/000,315	02/28/97	KINOSHITA	H 2477PD-5385

MM92/0424  
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EXAMINER  
MENEFEE, J

ART UNIT	PAPER NUMBER
2881	

DATE MAILED: 04/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/808,315

Applicant(s)

KINOSHITA ET AL.

Examiner

James Menefee

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17,20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

In response to Amendment E filed 16 February 2001, the abstract has been replaced and the specification has been amended. Claims 17, 20, and 21 are pending. The objection to the abstract from the previous action has been withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Kato. Kato describes a sapphire body in which a sharp edge can inherently be formed by a working plane and a cleavage plane. The angle between the two planes is shown to be 57.6 degrees (see abstract, figure 3), which the applicant admits to be less than about 70 degrees. Regarding the preamble “tool”, it is inherent that Kato describes a tool as Kato meets all of the claimed features as described above.

Claims 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Setsune. Setsune discloses a sapphire crystal body 1 having a major face and a working reference plane on an edge of the body comprising a cleavage plane along (i.e. substantially parallel to) a plane R of the crystal on the surface. Being substantially

parallel defines the angle to be between  $-10$  and  $+10$  degrees. The working reference plane being used as a mark constitutes intended use which does not given patentable weight.

### ***Response to Arguments***

Claim 17 was rejected in paper #20 as being anticipated by Kato. Previously cancelled claims 6-7 were rejected in paper #8 as being anticipated by Setsune. Pending claims 20-21 were added to replace claims 6-7 only to fix 35 USC 112 problems. Therefore, since these grounds for rejection are not new, the rejection is made final.

Applicant's arguments have been fully considered but they are not persuasive. Applicant argued in paper #21 that Kato does not anticipate pending claim 17. Applicant states that there is no sharp edge in Kato and that there is no plane formed by cleavage that is parallel to the R plane. Examiner contends that cleavage is typically done of sapphire along planes depending on the orientation of molecules in the sapphire, therefore it is inherent that the R and C planes are cleavage planes. Given that these planes are cleavage planes, it is also inherent that should these planes be used as cleavage planes then they will yield the  $57.6^\circ$  angle between a cleavage plane and a working plane R which is shown in Figure 3 of Kato as imaginary lines. Therefore there is disclosed a tool with a sharp edge formed by cleavage with a cleavage plane parallel to the plane R.

Applicant argued in paper #10 that Setsune does not anticipate now cancelled claims 6-7 (which are not patentably distinct from pending claims 20-21). Applicant argued that Setsune does not teach a major face or a working reference plane that is substantially parallel to a plane R. This argument is not persuasive. Setsune discloses in the Figure a sapphire block which is cubic. The top of the block, i.e. the face perpendicular to the plane of the page, may constitute the major face. There are disclosed end faces 16 and 17 which are produced by cleavage along the R surface. Therefore these are working reference planes on a peripheral edge of the plate that are substantially parallel to the R surface.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Menefee whose telephone number is (703) 605-4367. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Arroyo can be reached on (703) 308-4782. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

JM  
April 23, 2001

  
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